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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,599	12/15/2000	Lisa K. Nolan	255.0001 0122	1240

26813 7590 10/03/2003

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EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT PAPER NUMBER

1645

DATE MAILED: 10/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/738,599**Applicant(s)  
**Nolan et al.**Examiner  
**S. Devi, Ph.D.**Art Unit  
**1645**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 17, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires five months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None

Claim(s) objected to: 45

Claim(s) rejected: 30-33, 37-44, and 67

Claim(s) withdrawn from consideration: 35, 36 and 46-66

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other:

*S. Devi, Ph.D.*  
S. DEVI, PH.D.  
PRIMARY EXAMINER  
ART UNIT 1645

**ATTACHMENT TO ADVISORY ACTION**

**Item 2.**

The new limitation 'nucleotide' added to claim 42 was not presented previously, which changes the scope of the claim, thus requiring further consideration and/or a new search.

The newly added limitation 'an isolated' in claim 37 was not presented in this claim before. This added limitation along with the new limitations: 'wherein the nucleic acid molecule further ..... encoding the polypeptide' is a new combination not previously presented, and thus requires further consideration and/or a new search.

The amendments made to claim 41 change the scope of the claim. The deletion of some limitations from claim 41 along with the addition of new and previously not presented limitations: 'causes expression' of the polypeptide 'in an animal cell', requires further consideration at least under 35 U.S.C. § 112.

New claim 68, now presents a combination of nucleic acid molecules previously not examined and/or searched.

New claim 70 includes redundant and/or incorrect limitations, such as 'and ; and' as well as 'wherein the molecule further comprising', and therefore requires further consideration.

01 October, 2003

  
S. DEVI, PH.D.  
PRIMARY EXAMINER